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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/823,704 | 03/30/2001 | Shinichi Ito | 39303.20243.00 | 7453 |

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| EXAMINER | |
|---|---|
| LEROUX, ETIENNE PIERRE | |
| **ART UNIT** | **PAPER NUMBER** |
| 2161 | |

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/823,704 | ITO ET AL. | |
| | Examiner | Art Unit | |
| | Etienne P LeRoux | 2161 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *31 August 2004* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,4,6,9,12,22,24,34-37,50 and 51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,9,12,22,24,34-37,50 and 51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8312004* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

### *Continued Examination*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/31/2004 has been entered.

### *Claims Status*

Claims 1, 4, 6, 9, 12, 22, 24, 34-47, 50 and 51 are pending. Claims 2, 3, 5, 6, 7, 8, 10, 11, 13-21, 23, 25-33, 48 and 49 are canceled. Claims 1, 4, 6, 9, 12, 22, 24, 34-47, 50 and 51 are rejected as detailed below.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "displaying a list of music piece data sets offered for sale by the selling sites." The specification does not describe

in a clear and concise manner the process on making a list of music piece data sets. It is unclear what method is used to generate the list. For purposes of this Office Action, above limitation will not be given patentable weight.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "displaying a list of music piece data sets offered for sale by the selling sites." The scope of the invention cannot be determined because it is unclear whether the list is generated from a site or a plurality of sites. For purposes of this Office Action, above limitation will not be given patentable weight.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4, 6, 9, 12, 22, 24, 34-47, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No US 2002/0068991 issued to Fitzsimmons in view of US Pat No 5,949,492 issued to Mankovitz.

Claims 1, 4, 6, 9, 12, 22, 24 and 34:

Fitzsimmons discloses an apparatus for retrieving information from a site on a network, said apparatus comprising:

a display device [Fig 1, 120], an operator unit [keyboard, Fig 1], a processor device [Fig 3, 303] coupled with a removably attached external storage medium [Figs 2A, 2B], said display device and said operator unit, said removably attached external storage medium having prestored therein one or more items of first display information each for displaying an emulation screen imitating a screen of any one of one or more predetermined music piece data sites accessible via the network, and network address [bookmark key 115, Fig 1 because the URL of a site is stored by bookmarking] information assigned to the sites for calling up any one of the sites, said processor device being adapted to:

read out [Fig 5, par 47] a particular one of the items of the first display information stored in said external storage medium; cause the emulation screen described by the read-out first display information, to be displayed on said display

device; manipulate [Fig 5, par 47] via said operator unit a desired item of information on the emulation screen displayed on said display device, to thereby read out the network address [bookmark key 115, Fig 1 because the URL of a site is stored by bookmarking] information of a particular selling site corresponding to said emulation screen from said external storage medium and transmit [Fig 5, par 47] the read-out network address information to the network, in response to the transmitted network address information, receive from said particular sites via the internet, second display information for displaying a screen of the particular site; and switch the emulation screen, displayed on said display device, to the screen of the particular site on the basis of the received second display information [Fig 5 and par 47].

Fitzsimmons discloses the essential elements of the claimed invention as noted above except for a music piece data selling site. Mankovitz discloses a music piece data selling site [Fig 9, col 16, lines 48-58]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fitzsimmons to include a music piece data selling site as taught by Mankovitz for the purpose of providing the user with a personal copy of the music. The skilled artisan would have been motivated to improve the invention of Fitzsimmons per the above for the purpose of providing an on-line music store.

Notes:

With regard to claim 24, Fitzsimmons discloses in paragraph 47, that users can obtain further information from a WWW website based on an artifact selected while in the museum. Selecting information concerning an artifact from the

information of a plurality of artifacts on the WWW website reads on the claimed "partial music piece data."

Claims 35-39:

The combination of Fitzsimmons and Mankovitz discloses the elements of claims 1, 4, 6, 9 and 12 as noted above.

Furthermore, Fitzsimmons discloses wherein predetermined music piece data selling site is provided for each of said apparatus and handles music piece data that can be handled by said apparatus, and the emulation screen imitating the screen, described by said first display information, of the predetermined music-piece-data selling site is provided for each of said apparatus [Figs 1, 2A, 2B, paragraphs 47 and 64].

Claims 40, 44, 50 and 51:

Fitzsimmons discloses receiving, from said client terminal, first request information designating a desired music piece on the basis of said first request information received from said client terminal, transmitting, to said client terminal, display information for displaying the desired music piece in its entirety so that the entire desired music piece can be displayed on said client terminal on the basis of the display information; receiving, from said client terminal, second request information designating at least a portion of the displayed music piece; on the basis of said second request information received from said client terminal, creating partial music piece data that represent the desired music piece and correspond to the portion designated by said second request information [Fig 1, 120, Fig 3, 303, Figs 2a, 2B, Fig 1, 115, Fig 5, par 47].

Fitzsimmons discloses the elements of claim 40 as noted above. Fitzsimmons fails to disclose determining a selling price of the created partial music piece data. Mankovitz discloses

determining a selling price of the created partial music piece data [Fig 9 and col 16, lines 48-58]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fitzsimmons to include determining a selling price of the created partial music piece data as taught by Mankovitz for the purpose of providing the user with a personal copy of the music. The skilled artisan would have been motivated to improve the invention of Fitzsimmons per the above for the purpose of providing an on-line purchasing system.

Claims 41 and 42:

The combination of Fitzsimmons and Mankovitz discloses the elements of claim 40 as noted above. Furthermore, Mankovitz discloses wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical store [Fig 9, col 16, lines 48-58]

Claims 43 and 45:

The combination of Fitzsimmons and Mankovitz discloses the elements of claims 40 and 44 as noted above. Furthermore, Fitzsimmons discloses a step of transmitting the created partial music piece data to said client terminal [Fitzsimmons discloses in paragraph 47, that users can obtain further information from a WWW website based on an artifact selected while in the museum. Selecting information concerning an artifact from the information of a plurality of artifacts on the WWW website reads on the claimed "partial music piece data."]

Claim 46:

The combination of Fitzsimmons and Mankovitz discloses the elements of claims 44 and 45 as noted above. Furthermore, Fitzsimmons discloses wherein the partial music piece data to

be received from said server apparatus include musical score data indicative of a musical score and reproduction data for reproducing the music piece [par 47]

Claim 47:

The combination of Fitzsimmons and Mankovitz discloses the elements of claim 44 as noted above. Furthermore, Fitzsimmons discloses wherein the predetermined billing-related information is at least one of a credit card number, an address to which an application form for remittance is to be sent, and user information for use of electronic money [Fig 59].

***Response to Arguments***

Applicant's arguments submitted 8/31/2004, have been considered but are moot in view of the new ground(s) of rejection which are made in order to advance prosecution by minimizing arguments concerning semantics. Nevertheless, it is expedient to consider the gist of applicant's in an attempt to further clarify instant invention.

**Applicant Argument No 1:**

Applicant states in the first paragraph of page 20, "With respect to independent claims 1, 4, 6, 9, 12 and 22, neither Fujisaki nor Ortega contain any disclosure of displaying an emulation screen that imitates a screen of a predetermined music piece data selling sites (as recited in the claims). Rather, Fujisaki simply discloses an auction information communication system in which laser disks containing information associated with used cars are stored and can be displayed. The examiner points to the video disk player 532 in Fig 3 of Fujisaki as a disclosure of displaying emulation screen that imitates a screen of a predetermined music selling site; however, the video display player 52 simply contains data directed to information related to the

used cars for sale, and does not contain any display information for generating images of an emulation screen. Ortega, which fails to make up for this deficiency of Fujisaki, and does not contain any disclosure whatsoever directed to emulation screens. Instead, Ortega is simply directed to a search engine that compensates for misspelling of search terms entered by a user."

**Examiner Response No 1:**

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The previous Office Action rejected claims 1, 4, 6, 9, 12 and 22 over Fujisaki in view of Ortega. Fujisaki discloses the following in column 2, lines 4-20:

Each dealer terminal has basic pattern data storage means storing pattern data indicative of a basic display screen picture and exhibit data storage means storing data peculiar to articles on exhibit at the auction. When the system is started up, the host computer transmits a line connection signal to the front computers, whereby the host computer is connected to each of the front computers. The host computer then transmits auction data such as member registration data to the least significant front computers, and the data are stored in these computers. Further, the least significant front computers are connected to the dealer terminals, and data are extracted from the basic pattern storage means and exhibit data storage means of the dealer terminals, and these data are displayed on the corresponding display screen, in response to a command from the host computer.

Examiner maintains above disclosure by Fujisaki reads on the claim 1 limitation "one or more first display information for displaying an emulation screen imitating a screen of any one of one or more predetermined [music piece] data selling sites accessible via the network." Furthermore, Ortega (US Pat 6,144,958) discloses in the abstract a search engine used on the Web site of an online merchant to assist users in locating book titles, music titles, and other types

of products. Ortega discloses a website including music titles and thus the combination of Fujisaki and Ortega discloses above claim limitation. However, supra new ground(s) of rejection which are made in order to advance prosecution by minimizing arguments concerning semantics.

**Applicant Argument No 2:**

Applicant states in the second paragraph of page 20 "With respect to independent Claim 24, neither Fujisaki nor Ortega contain any disclosure of selecting a partial music piece on a client apparatus and then obtaining the partial music piece data from a server connected to the client apparatus over a network. The examiner simply does not point to any portion of Fujisaki or Ortega that remotely discusses selecting partial piece of music.

**Examiner Response No 2:**

Examiner is not persuaded. Consider the following excerpt from the MPEP § 2106. II.C Review the Claims:

Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris,* 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater,* 415F.2d 1393, 1404-05, 162 USPAQ 541, 550-551 (CCPA 1969). See also *In re Zletz,* 893 F.2d 319, 321-22, 13 USPQ2d 13201322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonable allow ....

Applicant does not particularly point to the specification to explicitly define the term "partial music piece." Examiner will thus give supra claim limitation its broadest reasonable interpretation and will interpret "partial piece of music" to be a selection of one piece of music from a plurality of music pieces on a particular web site.

**Applicant Argument No 3:**

Applicant states in the third paragraph of page 20 "with respect to claim 34, neither Fujisaki nor Ortega contain any disclosure of an external storage medium storing information for objects related to music piece data sets, whereby the objects have different display modes. Specifically, in the first display mode, the display information of an object is linked over a network to a server for downloading a music piece data corresponding to the displayed object, and, in the second display mode, a visual presentation of the object is retrieved from a directory of files located within the external storage medium. The Examiner's rejections does not make any mentions as to where in Fujisaki or Ortega exist any disclosures related to different display modes for a given object.

**Examiner Response No 3:**

Examiner is partially persuaded. As best examiner is able to ascertain, the first display mode is displaying music information that has been stored on the removable external storage medium. The second display mode is displaying information that is retrieved from a Web site which is related to the music information which is stored on the removable external storage. Examiner maintains that Fitzsimmons discloses above limitation.

**Further Applicant Arguments:**

Applicant on page 21 repeats arguments previously presented.

**Examiner Responds:**

Examiner is not persuaded. Applicant is referred to supra examiner responses.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4023. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272- 4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272- 2100.

Etienne LeRoux

November 26, 2004

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